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5/16/97

Larry L. Huston 32,994
Name of Attorney Registration No.
L. Huston
Signature of Attorney

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
IN RE APPLICATION OF
LETHA M. HINES
ROBB E. OLSEN
SERIAL NO.: 08/383,550
FILED: FEBRUARY 3, 1995
FOR: SANITARY NAPKIN HAVING
CORE PREDISPOSED TO A
CONVEX UPWARD
CONFIGURATION
P&G CASE: 5006C

GROUP ART UNIT: 3308
EXAMINER: CHO

PK
6/10/97
#24

REPLY TO EXAMINER'S ANSWER DATED MAY 7, 1997

The Assistant Commissioner for Patents
Washington, D.C. 20231

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GROUP 3300

Dear Sir:

The Examiner's Answer raises one new point. The Examiner does not retreat from his admission that the Glassman reference teaches an infinite number of lines of weakness. But, the Examiner's Answer attacks Appellants' arguments regarding the significance that Glassman teaches an infinite number of lines of weakness.

Particularly, the Examiner argues "when considering the obviousness of claims, one must consider the closest example of embodiment [sic] of the prior art with respect to the claims and not the furthest."¹ Appellants respectfully traverse.

¹ Examiner's Answer, page 5.

In considering the prior art, one cannot use the Appellants' own disclosure as a template to point the way to the proper embodiment in the prior art.² To do so impermissibly uses the Appellants' Specification as prior art against his own application.

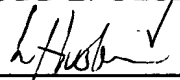
Instead, the prior art reference must be considered in its entirety, including the portions that lead away from the claimed invention.³ The Examiner is not free to pick the "closest" embodiment, while ignoring the admittedly infinite number of other embodiments.

At best, as admitted by the Examiner, the prior art gives unlimited choices in forming the lines of weakness. Without the Examiner's resort to Appellants' own Specification to find the line of weakness claimed in the present invention, one would not be motivated to choose the claimed line of weakness from an admittedly infinite number of choices. The Examiner's argument, *at best*, returns to the forbidden obvious to try standard.

The Examiner's rejection is either impermissibly based on Appellants' own specification, or, at best, impermissibly returns to the obvious to try standard. Under either perspective, the invention is not obvious. This Board is respectfully requested to reverse the outstanding rejections and allow Claims 1, 4-9, 12-17, and 19 which remain in the application.

Respectfully submitted,

FOR: LETHA M. HINES
ROBB E. OLSEN

By 
Larry L. Huston
Attorney for Appellants
Registration No. 32,994
(513) 634-2964

5/16, 1997
Cincinnati, Ohio

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² In re Stencel, 4 USPQ2d, 1071, 1073 (Fed. Cir. 1987); In re Schulpen, 157 USPQ 52, 55 (CCPA 1968).

³ MPEP 2141.02, citing Gore and Assoc. Inc. v Garlock Inc., 721 F2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied* 469 U.S. 851 (1984).